



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,938	08/02/2000	MICHEL LUSSIER	ADI-022	8689

21323 7590 11/08/2002

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 11/08/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,938

Applicant(s)

LUSSIER, MICHEL

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-23,26-31 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-23,26-31 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 26-29, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Okajima (5850702).

Okajima shows a chassis comprising three elongate elements (figure 7, 1R, 1L, and 1M) which extends from the medial to lateral sides of the footwear and extends from the toe end to the heel end of the footwear, and includes a cleat (4) as claimed.

3. Claims 1, 4-9, 19-21, 26-29, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Tong (5185943).

Tong shows a chassis (120, figure 16) with elongate elements (122) in the forefoot area and elongate elements in the rearfoot area (see figure 16) and a cleat (either elements 34 or elements shown at number 24 in figure 1) as claimed.

In reference to claim 35, the encapsulating midsole material (see column 8 lines 36-40) is considered to be a "skin" as recited in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trolle (1141889).

Trolle shows a shoe comprising a chassis (A) which extends the entire length and width of the shoe sole and a lug (11 or 12) which extends from the bottom of the chassis for connection to a cleat (C or D) substantially as claimed except for the exact materials for the chassis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymeric materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

6. Claims 1, 4, 6-10, and 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzi (1684676).

Lorenzi shows a shoe with a chassis (4) with elongate elements (shown in figure 1) in the heel and forefoot areas, and a cleat (13) substantially as claimed except for the exact materials for the chassis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymeric materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of a chevron to make the opening easier to manufacture/cut.

Art Unit: 3728

7. Claims 1, 5, 6, 8-10, 12-23, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese (5572805) in view of Tong (5185943) or Brown (D446917).

Giese (figures 111-116) shows a shoe sole with a chassis substantially as claimed except for the extent of the forefoot elements. Either Tong or Brown teaches extending forefoot elongated elements through the entire forefoot area (see figures 16 or figure 2). It would have been obvious to extend the forefoot elements as taught and shown by either Tong or Brown in the shoe of Giese to provide support for the entire length of the foot.

In reference to claim 4, Tong specifically teaches and shows the use of three elongate forefoot elements (122). Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide multiple elongate elements including three, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of chevron to make the opening easier to manufacture/cut.

In reference to claims 17 and 18, Giese teaches the well known use of different materials to provide different properties in different areas (column 13 lines 15-40). It would have been obvious to use different materials in different regions of the chassis of Giese as modified above to provide increased flexibility in areas which require such.

Art Unit: 3728

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, 8-10, 12-23, and 39 above, and further in view of Kendall (5713143).

Giese as modified above shows a chassis substantially as claimed except for the opening being open to the side. Kendall teaches opening a heel area to the side in a chassis. It would have been obvious to provide a side opening as taught by Kendall in the chassis of Giese as modified above to increase flexibility and comfort in the heel.

9. Claims 26-30 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, 8-10, 12-23, and 39 above, and further in view of Crowley (4393604).

Giese as modified above shows a shoe substantially as claimed except for cleats on the sole. Giese suggests different contours for the outsole to increase traction of the sole (column 14 lines 20-23). Crowley teaches forming an outsole with molded cleats thereon as is well known. It would have been obvious to provide cleats as taught by Crowley on the outsole of Giese as modified above to increase traction.

In reference to claims 35-38, Giese as modified above shows a shoe sole with a skin layer (the bottom layer in figures 112-115), an intermediate film (shown in figures 112-115, which inherently has color), and a chassis (19). The use of transparent materials for the outer sole elements is extremely well known to allow an interior element to be seen. It would have been obvious to make the outer skin layer transparent as is well known in the shoe of Giese as modified above to allow the interior elements to be seen.

Art Unit: 3728

10. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 26-30 and 35-38 above, and further in view of Cameron (3739497) or Barre (5473827).

Giese as modified above shows a shoe substantially as claimed except for providing a lug on the chassis which extends into the cleat. Cameron or Barre teaches providing lugs (32 or 23) on a chassis which extends into a cleat (24 or 11). It would have been obvious to provide lugs which extend into the cleat as taught by either Cameron or Barre in the shoe of Giese as modified above to increase stability and durability of the layered sole.

Drawings

11. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 10/7/02 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Response to Arguments

12. Applicant's arguments with respect to claims 1, 4-23, 26-31, and 35-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3728

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728